

DOCKET NO: 266419US6PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
DAISUKE KUROSAKI, ET AL. : EXAMINER: HUYNH, S.
SERIAL NO: 10/527,822 :
FILED: MARCH 15, 2005 : GROUP ART UNIT: 2424
FOR: DATA PROCESSING APPARATUS, :
DATA PROCESSING METHOD AND
PROGRAM, AND DATA PROCESSING
SYSTEM

PETITION UNDER 37 C.F.R. §1.181(a)(3)

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a Petition pursuant to 37 C.F.R. §1.181 (a)(3) requesting that the Examiner be instructed by the Commissioner or his representative to notify Applicants of proper consideration of the Information Disclosure Statements (IDS) that was filed on March 15, 2005.

STATEMENT OF FACTS

On March 15, 2005, Applicants filed the above-noted IDS under 37 C.F.R. § 1.97(h), together with the International Search Report indicating the relevance of the listed references as either "X", "Y" or "A", and the references cited therein. The PTO has not responded to this IDS filing by supplying Applicants with a copy of the Form PTO-1449 filed with this IDS, that have been properly initialed by the Examiner.

In a response filed on September 8, 2008, in an attempt to have the IDS filing of March 2005 considered, Applicants pointed out MPEP §609.04(a)III to the Examiner. Specifically, the Applicants noted that the identification of a reference on a Search Report as

merely an “X”, “Y”, or “A”, qualifies as a Statement of Relevancy for the underlying reference. In response to this distinction, the Examiner stated that:

... Since the reference provided in the IDS is not in English translation, it is not a legible copy.

In addition, if Applicants interpret the “concise explanation of relevance” requirement is met by merely “X”, “Y”, “A” in the Search Report, will Applicant admit Claims 1-4, 21-24 are anticipated by JP2002-135809A or JP11-25541 as indicated in the Search Report?

As can be seen from the above, not only has the Examiner refused to consider the submitted references of the Search Report properly indicated as either “X”, “Y”, or “A”, but also appears to be requiring an admission based upon the submission of the Search Report.

POINT FOR REVIEW

MPEP §609.04(a)III states that:

III.CONCISE EXPLANATION OF RELEVANCE FOR NON-ENGLISH LANGUAGE INFORMATION

. . . Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be **satisfied by submitting an English-language version of the search report or action** which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an “X”, “Y”, or “A” indication on a search report. . . .

Applicants respectfully submit that the IDS filing of March 15, 2005 complies with MPEP § 609 as the Search Report accompanying the IDS identified the underlying references as either “X”, “Y”, or “A.”

37 C.F.R. §1.97(h)

...(h) The filing of an Information Disclosure Statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in §1.56(b).

Applicants are unaware of any requirement which requires an Applicant to characterize references of a Search Report as being prior art based upon the designation of

references as "X", "Y", or "A" in the Search Report. Nevertheless, the Office appears to be requesting such an admission at page 3 of the Official Action of November 6, 2008.

ACTION REQUESTED


In light of the above, it is respectfully requested that the Examiner be directed to provide Applicants a copy of the above-noted Form PTO-1449 filed March 15, 2005, properly initialed by the Examiner in correspondence with the rules.

Furthermore, it is respectfully requested that the Examiner be directed to withdraw his request for the admission outlined at paragraph 3 of the Official Action as 37 C.F.R. §1.97(h) states that the submission of an Information Disclosure Statement is not construed as an admission.

Respectfully submitted,
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 08/07)


Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Scott A. McKeown
Registration No. 42,866